

### **REMARKS**

This is in full and timely response to the non-final Office Action dated March 31, 2005 (Paper No. 20050328). The present Amendment amends claims 1-19 and 21 to address minor matters of form and syntax. Claim 20 has been amended in order to further clarify a portion of the scope sought to be patented, and otherwise disputes certain findings of fact made in connection with the rejection of the claim. No new matter has been added. Accordingly, claims 1 to 21 are presently pending in the application, each of which is believed to be in condition for allowance. Reexamination and reconsideration in light of the present Amendment and the following remarks are respectfully requested.

#### **Claim Rejections- 35 U.S.C. § 102**

In the Action, claims 1-4 and 6-21 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,373,817 to Kung ("Kung"). This rejection is respectfully traversed.

Independent claim 1 recites, *inter alia*, an apparatus for filtering electronic mail and notifying a user, **residing in a set top box** connected between a television content provider, an Internet provider having an e-mail server, and a television.

Independent claim 19 recites, *inter alia*, a method of filtering e-mail messages and notifying a user, comprising: **installing a software program on a set top box**, wherein said set top box is connected both to a TV content provider and an e-mail server.

Independent claim 21 recites, *inter alia*, a software program application for filtering electronic mail and notifying a user, **residing on a set top box** connected between a television content provider, an Internet provider having an e-mail server, and a television.

In contrast, although Kung arguably discloses an IP central station (200) connected to a broadband residential gateway (300) providing an interface to a television, connection to a cable television set top device, and an Ethernet connection, Kung fails to disclose, teach or suggest at least an apparatus for filtering electronic mail and notifying a user, **residing in a set top box** as recited in claim 1. *See, e.g.*, col. 4, lines 32 to 60. Likewise, Kung fails to disclose, teach or suggest at least

**installing a software program on a set top box** as recited in claim 19, and a software program application for filtering electronic mail and notifying a user, **residing on a set top box** as recited in claim 21. *See, e.g.*, col. 4, lines 32 to 60.

Currently amended, independent claim 20 recites an e-mail filtering and notification apparatus, comprising, *inter alia*, user input means for **allowing a user to specify** e-mail filter criteria and **notification icons**; *inter alia*, wherein said notification icons **relate to the subject matter of said arriving e-mail**.

In contrast, although Kung arguably discloses setting preference levels for calling parties, status screens on an interactive display provided for multimedia mail, and displaying icons on an LCD/LED showing the identity of the owner of the message, Kung fails to disclose, teach or suggest at least specifying notification icons related to the subject matter of arriving e-mail as recited in current claim 20. *See, e.g.*, col. 35, line 44 to col. 36, line 4 and col. 22, line 37 to col. 23, line 26.

Accordingly, because Kung fails to disclose, teach or suggest each and every limitation of claims 1, 19, 20, and 21, a *prima facie* anticipation rejection has not been established, and withdrawal of this rejection is respectfully requested. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”).

#### Dependent Claims

Claims 2 to 18 depend from claim 1. By virtue of this dependency, Applicant submits that claims 2 to 18 are allowable for at least the same reasons given above with respect to claim 1. In addition, Applicant submits that claims 2 to 18 are further distinguished over Kung by the additional elements recited therein, and particularly with respect to each claimed combination. Applicant respectfully requests, therefore, that the rejection of claims 2 to 18 under 35 U.S.C. § 102 be withdrawn, and these claims be allowed.

Claim Rejections- 35 U.S.C. § 103

In the Action, claim 5 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,373,817 to Kung (“Kung”) in view of U.S. Patent No. 6,397,167 to Skinner (“Skinner”). This rejection is respectfully traversed.

Claim 5 depends from claim 1. By virtue of this dependency, Applicant submits that claim 5 is allowable for at least the same reasons given above with respect to claim 1. In addition, Applicant submits that claim 5 is further distinguished over Kung by the additional elements recited therein, and particularly with respect to each claimed combination. Applicant respectfully requests, therefore, that the rejection of claim 5 under 35 U.S.C. § 103 be withdrawn, and that claim 5 be allowed.

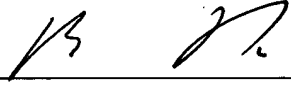
Conclusion

For at least the foregoing reasons, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. If the examiner has any comments or suggestions that could place this application in even better form, the examiner is invited to telephone the undersigned attorney at the below-listed number.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SOA-330 from which the undersigned is authorized to draw.

Dated: May 20, 2005

Respectfully submitted,

By  47,255

Ronald P. Kananen

Registration No.: 24,104

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorney for Applicant

DC193774